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In re Application of :
ZELLMER et al. :
Application No.: 10/523,282 : DECISION ON REQUEST
PCT No.: PCT/EP03/14462 : UNDER 37 CFR 1.497(d)
Int. Filing Date: 18 December 2003 :
Priority Date: 19 December 2002 :
Attorney Docket No.: F-8479 :
For: POCKELS CELL :

This decision is in response to applicants' "Request to Correct Inventorship under 37 CFR 1.497" filed 28 November 2005. The \$130 petition fee under 37 CFR 1.17(h) has been charged to Deposit Account no. 10-1250, as authorized.

BACKGROUND

On 18 December 2003, applicants filed the above-captioned international application which claimed a priority date of 19 December 2002. The international application named: Holger Zellmer; Peter Riedel; and Thomas Fehn as applicant/inventors. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 19 June 2005.

On 03 February 2005, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a basic national fee; a translation of the international application; and an Information Disclosure Statement.

On 26 July 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 28 November 2005, applicants filed "Request to Correct Inventorship under 37 CFR 1.497" which included a declaration executed by: Stefan Balle; Sven Poggel; and Thomas Fehn.

On 24 January 2006, the United States Designated/Elected Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a

two-month time limit in which to respond.¹

DISCUSSION

In the instant case, the international application named Holger Zellmer; Peter Riedel; and Thomas Fehn as applicant/inventors. Applicants request to add Stefan Balle and Sven Poggel as applicant/inventors. Additionally, applicants request to delete Holger Zellmer and Peter Riedel as applicant/inventors. In order to correct an error in naming the inventor(s) made during the international stage in the national stage, a submission under 37 CFR 1.497(d) is required.

A submission under 37 CFR 1.497(d) to correct an error in naming inventorship requires: (1) a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part; (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.497(a); (3) the fee set forth in 37 CFR 1.17; and (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b). Applicants have satisfied items (2) and (3).

Regarding item (1), applicants have not provided a statement from Holger Zellmer and Peter Riedel which states that the error in inventorship occurred without deceptive intent.

Regarding item (4) above, the written consent of the assignee is not acceptable. Firstly, the "Written Consent of the Assignee" does not list the name of the individual signing on behalf of LINOS Photonics GmbH & CO. KG. Secondly, the assignee has not established its ownership to the application in accordance with 37 CFR 3.73. See Manuel of Patent Examining Procedure (MPEP) §324 and Statement under 37 CFR 3.73(b) (Form PTO/SB/96).

CONCLUSION

For the reasons discussed above, applicants' request under 37 CFR 1.497(d) is DISMISSED without prejudice.

The Notification of Missing Requirements dated 26 January 2006 was mailed in error and is hereby VACATED.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. A proper response must include a statement from Holger Zellmer and Peter Riedel and a written consent of assignee in compliance with 37 CFR 3.73(b). Extensions of time may be obtained under 37 CFR 1.136(a).

¹The Notification of Missing Requirements dated 26 January 2006 was mailed in error and is hereby vacated.

Any further correspondence with respect to this matter should be addressed to:
Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box
1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the
attention of the Office of PCT Legal Administration.

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